

In re Application of: Wilt et al.
Application No.: 10/077,568

Remarks

In the application, claims 1 through 18 are pending. No claims currently stand allowed.

Pursuant to 35 U.S.C. § 121, the Office Action dated December 3, 2003, requires an election of one of three restriction groups. The Office Action groups claims 1 through 3 into Group I, claims 4 through 10 into Group II, and claims 11 through 18 into Group III.

The restriction requirement is respectfully traversed for the reasons set below. However, applicants provisionally elect the claims in Group III.

The restriction requirement is improper because the Office Action does not show that a search and examination of the entire application causes a *serious burden* as required by Section 803 of the MPEP:

If the search and examination of an entire application can be made *without serious burden*, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a *serious burden* on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

MPEP § 803 at page 800-4 (emphasis added). Contrary to the requirements for a proper restriction requirement, maintaining this restriction requirement places a “serious burden” on the Patent Office, on the public, and on the applicants. Filing two more applications directed to the non-elected restriction groups unnecessarily burdens the Patent Office because it must assume the additional and unnecessary labor involved in examining three separate applications. The public is burdened because it has to locate and review three patents instead of one in order to fully ascertain the scope of the patent protection provided to the subject matter in the specification. Finally, the applicants are burdened because they must bear the expense of filing and prosecuting multiple applications.

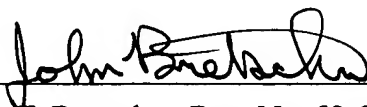
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In contrast to the burdens on the Patent Office, on the public, and on the applicants, the burden of examining all of the claims instead of just those of one restriction group is negligible. In this regard, the searches that the Examiner must conduct for the three groups of claims overlap to a great extent. In fact, a complete search of one group of claims is likely to include all of or at least most of the field of search for the other claims.

Conclusion

The restriction requirement should be withdrawn, and the Examiner is respectfully requested to examine all of the claims for compliance with the relevant requirements of the patent statutes, rules, and regulations. In any event, applicants provisionally elect Restriction Group III which consists of claims 11 through 18. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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